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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/773,284	02/09/2004	Guillaume Mathieu	24884	8735

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EXAMINER

STASHICK, ANTHONY D

ART UNIT	PAPER NUMBER
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3728

DATE MAILED: 04/07/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/773,284	Applicant(s) MATHIEU ET AL.	
	Examiner Anthony Stashick	Art Unit 3728	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 January 2006.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5 and 7-30 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5 and 7-30 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 09 February 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Objections

1. Claim 13 is objected to under 37 CFR 1.75(c), as being of improper dependent form for failing to further limit the subject matter of a previous claim. Applicant is required to cancel the claim(s), or amend the claim(s) to place the claim(s) in proper dependent form, or rewrite the claim(s) in independent form. Claim 13 contains the negative limitation that the elastically deformable element does not extend upwardly at the medial and lateral edges of the outsole. Since the elastically deformable element of the instant application has a thickness at its ends, it must extend upwardly for the thickness of the material. Therefore, this limitation is contradictory to the claims from which it depends.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

3. Claims 1, 3-5, 7-9, 13-14, 25-26 and 29 are rejected under 35 U.S.C. 102(b) as being anticipated by Preman et al. 5,224,280. Preman et al. '280 discloses all the limitations of the claims including the following: an upper 33; an outer bottom assembly 1; the outer bottom assembly comprising an outsole 2; an elastically deformable element 3; the elastically deformable element having a substantially arch shape in a transverse direction of the outer bottom assembly (see Figures 3-5); the elastically deformable element having an uppermost

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portion beneath a lower end of the upper (see Figure 3); the arch shape of the elastically deformable element extending downward from the uppermost portion to medial and lateral edges, respectively, of the outsole (see Figure 3); the elastically deformable element being located in a heel zone of the article of footwear (see Figures 1-3); a layer of shock-absorbing material 4 positioned between the elastically deformable element and the outsole (see Figure 3); the elastically deformable element includes an upper end (arched portion) with a substantially planar zone (with 22 located therein from back of heel to front of heel); the planar zone has a width of about 15-20 millimeters (see Figures 4 and 5, from back end to front end); the elastically deformable element comprises at least one medial arm 14 and at least one lateral arm (14 on other opposite side of element); the layer of shock-absorbing material comprises at least one recess 22 between the layer and the elastically deformable element; the elastically deformable element is fixed to the upper via a connecting member (sides of outsole); an outer stiffener 5 is positioned between the upper of the shoe and the elastically deformable element; the elastically deformable element is located in the heel zone of the article of footwear (see Figures 1-3); the arch shape of the elastically deformable element extends transversely from the uppermost central portion at least to a position vertically beneath a medial side of the upper and at least to a position vertically beneath a lateral side of the upper (see Figure 3, upper would be located inside the vertical sides of 5 which translate to the ends of the arch area of 3); the intermediate member 5 extends at least from the position vertically beneath the medial and lateral sides of the upper (see notation immediately above for 5). The elastically deformable element has an upwardly facing convex surface between the medial and lateral edges (see Figure 3, top surface of arch shape is upwardly convex). With respect to claim 13, inasmuch as the

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thickness of applicant's elastically deformable material extends upwardly, the elastically deformable element of Preman et al. '280 does as well.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 2, 10-12, 21-24, 27-28 and 30 are rejected under 35 U.S.C. 103(a) as being obvious over Preman et al. 5,224,280 as applied above. Preman et al. '280 as applied above discloses all the limitations of the claim except the specific Young's modulus of the HYTREL™, the elastically deformable element being able to be made of polyurethane or polyethylene, or the hardness of the shock absorbing material and the intermediate member and the material makeup of the connecting member. Preman et al. '280 teaches that the material 5 (also the connecting member) located between the upper and the elastically deformable element is made of foam or other material of similar characteristics. Since the properties of HYTREL™ are well known and, depending upon thickness of the material, it would be well within the skill of one of ordinary skill in the art to use HYTREL™ or foam with a Young's modulus of greater than 40 Mpa and a hardness between 20 and 200 Asker to impart the desired elasticity and resiliency to the elastically deformable element or intermediate element. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to make the insert of Preman et al. '280 out of HYTREL™ with a Young's modulus greater than 40 Mpa to impart the

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desired elasticity and resiliency for support of the users foot during use or make the intermediate member a foam of any known material including polyurethane or polyethylene to aid in cushioning the user's foot during use.

6. Claims 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over Preman et al. 5,224,280 as applied to claim 1 above in view of Chu 6,470,599. Preman et al. '280 as applied to claim 1 above discloses all the limitations of the claims except the elastically deformable member being located in the forefoot area. Chu '599 teaches that an elastically deformable member 16 can be located in the forefoot of a shoe sole to aid in gaining grip while using the shoe for climbing mountains. Therefore, it would have been obvious, to one of ordinary skill in the art at the time the invention was made, to place the elastically deformable element of Preman et al. '280 in the forefoot area of the shoe to aid in gaining grip when using the shoe for mountain climbing.

7. Claims 16-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Preman et al. 5,224,280 as applied to claim 1 above in view of DE 101 07 824 (DE '824). Preman et al. '280 discloses all the limitations of the claims except the elastically deformable element being located in both the forefoot and the heel area of the sole and the height difference in the elastically deformable element between the forefoot and heel areas. DE '824 teaches that a shoe sole can have an elastically deformable element 16 in both the forefoot and heel of a shoe sole (see Figure 3). Furthermore, it teaches that a sole reinforcement element (that located above 16 in Figure 9) can be part of the elastically deformable element (16 embedded therein) and that the sole reinforcement element is planar in the front area (see Figure 4). Therefore, it would have been obvious to make the elastically deformable element of Preman et al. '280 present in both

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the forefoot and heel area of the sole, as taught by DE '824, to provide support and cushioning to the entire foot of the user's that takes the highest forces during the gait cycle. With respect to claims 17 and 18, the height of the front or rear elastically deformable element would be determined by the amount of cushioning and support desired. With respect to claim 20, the inclined zone connecting the front and rear portions of the sole reinforcement element can be seen in the arch area in Figures 6A, 6B and 6C.

Response to Arguments

8. Applicant's arguments filed January 13, 2006 have been fully considered but they are not persuasive with respect to Preman et al. '280. Response to these arguments can be found in the rejections set forth above.

Conclusion

9. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event,

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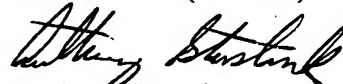
however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Anthony Stashick whose telephone number is 571-272-4561.

The examiner can normally be reached on Monday-Thursday 8:30 am to 4:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Mickey Yu can be reached on 571-272-4562. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Anthony Stashick
Primary Examiner
Art Unit 3728

ADS